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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.								
10/502,280	05/11/2005	Andreas Myka	617-011873-us	3300								
2512 PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824	7590 06/15/2009		<div>EXAMINER</div> <div>LIN, WEN'TAI</div> <table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>2454</td><td></td></tr><table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>06/15/2009</td><td>PAPER</td></tr></table></table>		ART UNIT	PAPER NUMBER	2454		MAIL DATE	DELIVERY MODE	06/15/2009	PAPER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/502,280

**Applicant(s)**

MYKA ET AL.

**Examiner**

Wen-Tai Lin

**Art Unit**

2454

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,5-7,9-15,17-19,21-30,32-34,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5-7,9, 12-15,17-19,21, 24-30,32-34,36 and 37 is/are rejected.
- 7) ☒ Claim(s) 10,11,22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 2-3, 5-7, 9-15, 17-19, 21-30, 32-34 and 36-37 are presented for examination.
2. Claim--Claim 13-15, 17-19 and 21-24 are objected to because of the following issues/informalities:
  - (i) The terms "the repositories" and "the terminals" in claim 13 appear to lack antecedent basis.
  - (ii) Claim 24 depends on a canceled claim (claim 16).
  - (iii) The term "personalized performed" in claim 17 appears to be a typo of "personalized service performed."
3. Applicant is reminded to review the punctuations used in the claim set, where " ; " (semicolon) and " , " (comma) have not been consistently placed at the end of each featured limitation.
4. With all the dependent claims started with "A" or "An", it is uncertain whether these dependent claims inherit only their respective parent claims or not. To avoid the indefinite scope of these dependent claims, Applicant is requested to amend these claims by putting "the" article in place.

5. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

*Claim Rejections – 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 13-15, 17-19, 21-24, 29-30 and 32 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The method is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

To overcome the 101 rejection, Applicant is recommended to replace the word “comprising” in the preamble of claims 13 and 29 with “comprising the following computer-implemented steps”.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (hereafter "Fujii") [U.S. PGPub 20050229009].

9. As to claim 13, Fujii teaches the invention substantially as claimed including: a method comprising:

acquiring personal content in a terminal [e.g., 201, Fig. 6], said personal content including at least one of photographs, text, video, speech, calendar information, and location information [e.g., par 0002];

storing at least a part of said personal content in the terminal [e.g., 211-216, Fig. 6; 234, Fig. 9];

selecting and transferring through a telecommunications system at least a part of the personal content between the mobile terminal and a remote data repository [e.g., 201, 202, Fig. 6; par 0051];

storing the transferred personal content in the at least one remote data repository [e.g., 222-226, Fig. 6; par 0051];

assigning at least one of the repositories for the use of the terminals, and providing the

repositories with a processor for accessing the personal content from at least one terminal; receiving a request for a service involving the use of personal data and associating the request with a personalized service [e.g., par 009; [e.g., par 0009; note that it is inherent that multiple clients can be connected to the same service provider via the network shown in Fig. 6];

analyzing the personal content [211, Fig. 6; e.g., obtain the features of the fingerprint] and generating information based on the personal content and further combining the generated information based on the personal content with other data obtained from external databases [paragraphs 0249-0250, 0260 and 0323 -0324; 216, Fig. 6; i.e., encrypting the fingerprint features with a primary key (213, Fig. 6) obtained from a remote key database (226, Fig. 6)];

in response to the generation of information based on the personal content and combining of other data obtained from external databases, generating the associated personalized service incorporating generated information based on the personal content and combined with the other data obtained from external databases; and providing said personalized service to the terminal [e.g., paragraphs 0047, 0250 and 0334].

Fujii does not specifically teach that the client-side equipment is a portable terminal.

However, compact, portable client-side equipments such as PC notebooks and netbooks are very popular devices in the field of computer/network application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to also include mobile terminals as Fujii's client-side equipments because it broadens Fujii system's application base.

10. Claims 2-3, 5-7, 9, 12, 14-15, 17-19, 21, 24-30, 32-34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (hereafter "Fujii") [U.S. PGPub 20050229009], further in view of Durrett [U.S. Pat. No. 5964830].

11. As to claim 14, Fujii focuses on the teaching of securely restore the biometric features as a way of authentication for personalized service. Fujii does not specifically the follow-up services provided by the service provider.

However, in the same field of endeavor Durrett teaches that after a user has been successfully authenticated with fingerprint identification process, the user may:

select data to be retrieved from an external data storage, the selection to be made at least partially on the basis of said generated information based on the personal content [Durrett: col. 2, lines 40-49];

receiving said selected data; associating said received data with the personal content stored in the data repository; and providing the associated personalized service, the service to utilize said received data [Durrett: col. 7, lines 14-21].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Fujii and Durrett by providing personalized services such as virtual storage services with Fujii's biometric authentication method because it enables the stored data to be more securely protected in a network environment.

12. As to claims 15 and 18-19, Durrett discloses a method according to claim 13, the method further comprising:

retrieving at least one stored object and/or item of data from the remote data repository; and performing an action as a result of which information is generated, the action being to utilize the retrieved object and/or said data; subscribing to a service by sending a request to a server; processing said request; and in response to said processing, accessing an object and/or stored information in the remote data repository or sending an object and/or personal content to provide

the service requested.

[e.g., Durrett: col.2 lines 50-54; Figs. 6A-6C].

13. As to claim 17, Fujii discloses a method according to claim 13, further comprising generating charging information on the basis of the personalized service performed [i.e., it is obvious that Durrett's virtual disk is a payable service].

14. As to claim 21, Fujii discloses a method according to claim 18, wherein an object and/or generated information based on personal content is identified in the request, the object and/or the generated information based on personal content defining the action to be performed by the server [note that Durrett teaches that the key derived from the user's fingerprint is used for encrypting the objects stored in the subscribed virtual disk].

15. As to claim 24, Fujii discloses a method according to claim 15, wherein said generation of information based on personal content includes at least performing i) optical character/text recognition or ii) pattern recognition [note that the key matching process is a pattern recognition process based on the scanned fingerprint (col.5 lines 45-51 and col. 2, lines 50-54)].

16. As to claims 2-3, 5-7, 9, 12, 25-30, 32-34 and 36-37, since the features of these claims could also be found in claims 13-15, 17-19, 21 and 24, they are rejected for the same reasons set forth in the rejection of claims 13-15, 17-19, 21 and 24 above.



17. Claims 10-11 and 22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Rhoads [U.S. Pat. No. 20040022444]  
Uchida [U.S. Pat. No. 6751734]

19. Applicant's arguments with respect to claims 2-3, 5-7, 9, 12, 14-15, 17-19, 21, 24-30, 32-34 and 36 on 4/9/09 have been considered but are moot in view of the new ground(s) of rejection.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

21. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571)272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquiries draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

June 11, 2009

/Wen-Tai Lin/

Primary Examiner, Art Unit 2454